UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,259	06/05/2001	Teruo Tanaka	NIT-278	5965

24956 7590 03/02/2007

MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.
1800 DIAGONAL ROAD
SUITE 370
ALEXANDRIA, VA 22314

EXAMINER	
CHENCINSKI, SIEGFRIED E	
ART UNIT	**PAPER NUMBER**
3692	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/873,259	TANAKA ET AL.	
	Examiner	Art Unit	
	Siegfried E. Chencinski	3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 December 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claim 1 contains the expression "extracting" and variations thereof. There is insufficient antecedent basis** for this limitation in the claim. The word "extracting" or variations or synonyms therefor are not contained in the specification. Extracting implies the use of force against or from "someone unwilling" (Merriam-Webster Collegiate Dictionary, Tenth Edition, 1998). No such use of force is described or implied in Applicant's specification. In contrast, Applicant's specifications consistently uses the expression "communicating with" throughout the steps, which suggests a cooperative arrangement.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. **Claims 1-4 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Huberman (US Patent 5,826,244) in view of Koopersmith (US Pregrant Publication 2001/0042002 A1).

Re. Claim 1, Huberman discloses a method for an auction brokerage service provided by a computer that resides between an information terminal of a user and auction servers to perform brokerage operation for an auction. Huberman also discloses a computer automated third party broker service for administering an auction process

between sellers and prospective customers (Abstract, ll. 1-2). Huberman further discloses multiple auctions (Col. 7, ll. 12-15; Col. 18, ll. 38-41) and communicating with the customer's user information terminal to notify of the auction result information (Col. 3, l. 59 – Col. 4, l. 18).

Huberman does not explicitly disclose a method for:

- Extracting information of said auction servers suitable for the user's conditions from among stored information related to said auction servers, in response to a request from said information terminal;
- Transmitting an auction request to each of the auction servers that have been selected by the user from among the extracted auction servers to receive a notification that an auctioned commodity of the user has been registered at the auction servers;
- Receiving auction result information from the selected auction servers;
- Notifying said information terminal of the auction result information and outputting the auction result, wherein said auction servers are other brokerage computers which accept bids from a plurality of information terminals for the auctioned commodity.

However, third party services involving computer automation were well known at the time of applicant's invention. Huberman discloses such a service. The examiner takes Official Notice that a well known computer automated third party service provider is eBay ®, which operates an auction market for buyers and sellers of a wide variety of products and services. Importantly, historically well known is participation in multiple auction markets by sellers. For example, many commodities are simultaneously registered and offered for sale in a plurality of auction markets, both nationally in the USA as well as globally. Such commodities include financial securities such as publicly traded common stocks (Examples are in the US - New York Stock Exchange, American Stock Exchange, NASDQ, Philadelphia Stock Exchange, Pacific Stock Exchange, OTC (Over the Counter); outside the US – Stock exchanges in London, Paris, Frankfurt, Tokyo, Kong Kong, and more. Stocks are listed on a plurality of stock exchanges for a

variety of reasons related to how the company prefers to manage the market for its security). Commodities such as oil and oil derivatives such as gasoline, jet fuel and certain plastic resins, agricultural commodities such as wheat, corn, soy beans, sugar, coffee and cocoa, metals such as gold, silver and copper are traded on a plurality of exchanges and have had their contracts listed on multiple exchanges – e.g. Chicago Board of Trade, Chicago Mercantile Exchange, the New York Mercantile Exchange and exchanges located in major trading centers around the world, such as London, Paris and Tokyo. Each of these auction markets has been in operation for generations, even for over a century. Each was offering its services online through computer automation at the time of Applicant's invention. It was well known at the time of Applicant's invention that the computer systems of these auction exchanges provide the various communications responses such as the confirmation of commodity registration offered for sale and to provide auction result information.

Further, locating servers which offer certain information or services was also well known at the time of Applicant's invention. For example, at the time of applicant's invention a rapidly growing information search facility service industry by such companies as Google ® have made search for service provider servers such as those of auction services quite simple. For example, Koopersmith discloses a search server searching a data base of web site addresses for web sites fitting a certain word definition. Such a search is likely to bring up a number of qualified web sites, which are essentially contained in a server. Koopersmith's example illustrates a search for suppliers of toasters (page 1, [0004]-ll. 8-16). It would have been obvious to the practitioner that a similar automated search would have located servers which offer commodity auction servers which meet the seller's commodity criteria. Hence, the disclosures by Huberman and Koopersmith, combined with the well known practices cited above, would have made it obvious to the ordinary practitioner to

- Extracting information of said auction servers suitable for the user's conditions from among stored information related to said auction servers, in response to a request from said information terminal;

- Transmitting an auction request to each of the auction servers that have been selected by the user from among the extracted auction servers to receive a notification that an auctioned commodity of the user has been registered at the auction servers;
- Receiving auction result information from the selected auction servers;
- Notifying said information terminal of the auction result information and outputting the auction result, wherein said auction servers are other brokerage computers which accept bids from a plurality of information terminals for the auctioned commodity.

Therefore, it would have been obvious to an ordinary practitioner at the time of Applicant's invention to have combined the disclosures of Huberman with the disclosures of Koopersmith and with the incorporation of the above mentioned well known practices for the purpose of providing computer automated third party multi auction brokerage services for a client through a computer link, motivated by an opportunity to establish better prices for the sale of commodities through a more efficient auction process through electronically networked, highly automated, brokered auctions (Huberman, Col. 2, ll. 50-51, 55-56).

Re. Claim 2, neither Huberman nor Coopersmith explicitly disclose a method for auction brokerage service further comprising a step of gathering trade information of how the auctioned commodity has been bid for at the selected auction servers and notifying the other selected auction servers and notifying the other selected auction sites of the highest tendered price of the bids in order to adjust the bid prices to the highest price over all the auction sites. However, Applicant has chosen to define the notification step in the specification as meaning the option of "Specifically, the auction site monitoring section 242 may place .... Or it may alter the lower limit of the desired price of such commodity into the highest tendered price in the name of the user" (Specification, page 15, ll. 13-23). The option of changing an offer price such as the minimum acceptable price in an auction was well known at the time of Applicant's invention. This well known and well established practice not only has a basis as an old

practice prior to the consummation of a transaction, but it is also embedded in US law. An offer may be changed or withdrawn at any time before it is legally accepted. Therefore, it would have been obvious to an ordinary practitioner at the time of Applicant's invention to have combined the disclosures of Huberman with the disclosures of Koopersmith, Official Notice and with the incorporation of the above mentioned well known practices for the purpose of gathering trade information of how the auctioned commodity has been bid for at the selected auction servers and notifying the other selected auction servers and notifying the other selected auction sites of the highest tendered price of the bids in order to adjust the bid prices to the highest price over all the auction sites, motivated by an opportunity to establish better prices for the sale of commodities through a more efficient auction process through electronically networked, highly automated, brokered auctions (Huberman, Col. 2, ll. 50-51, 55-56).

Re. Claim 3, neither Huberman nor Coopersmith explicitly disclose a step of requesting the selected auction servers to alter the desired price specified by the user according to the user's instruction when the computer has found that there is no bid for the commodity at any relevant auction sites by the date specified by the user. The practice of changing an offer price such as by reducing the offer price when there have been no offers at a given price was well known in the art of auctions and in the basic selling art in cases when an item was confirmed to have been legitimately exposed to prospective buyers ("where the commodity had been registered (in an auction) by the date specified by the user"). Therefore, it would have been obvious to an ordinary practitioner at the time of Applicant's invention to have combined the disclosures of Huberman with the disclosures of Koopersmith, Official Notice and with the incorporation of the above mentioned well known practices for the purpose of neither Huberman nor Coopersmith explicitly disclose, motivated by an opportunity to establish better prices for the sale of commodities through a more efficient auction process through electronically networked, highly automated, brokered auctions (Huberman, Col. 2, ll. 50-51, 55-56).

Re. Claim 4, neither Huberman nor Coopersmith explicitly disclose a method for notifying the other auction sites of canceling the registration of the commodity but an auction site with which the trade has concluded. Removing an item from being offered

for sale after a sale has been made is a logical step to take, and was a well established practice in the art at the time of Applicant's invention. Therefore, it would have been obvious to an ordinary practitioner at the time of Applicant's invention to have combined the disclosures of Huberman with the disclosures of Koopersmith, Official Notice and with the incorporation of the above mentioned well known practices for the purpose of notifying the other auction sites of canceling the registration of the commodity but an auction site with which the trade has concluded, motivated by an opportunity to establish better prices for the sale of commodities through a more efficient auction process through electronically networked, highly automated, brokered auctions (Huberman, Col. 2, ll. 50-51, 55-56).

3. **Claims 5-10 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Huberman.

Re. Claims 5 & 8, Huberman does not explicitly disclose the detailed specifics of a method executed by a brokerage computer residing between a user computer of an auction user and auction computers of auction organizers to perform brokerage operations for auctions, the method and system comprising steps of:

(a) receiving information about an auctioned commodity and at least one specified auction organizer from the user computer;

(b) sending the information about the auctioned commodity to the auction computers of the specified auction organizers;

(c) gathering trade information of how the auctioned commodity has been bid for at the specified auction site;

(d) notifying the other auction computers of the highest bid price of the bid prices in order to adjust the bid prices to the highest price over all the auction computers; and

(e) taking an action in accordance with conditions specified by the user computer if the brokerage computer has found that there is not bid for the commodity at any auction computers by the date specified by the user including notifying said user computer of the auction result information and out putting the auction result, wherein said auction

computers are other brokerage computers which accept bids from a plurality of other computers for the auctioned commodity.

However, at the time of Applicant's invention,

(1) Use of third party service providers or brokers performed through computer automated methods and means was well known (Huberman, Col. 1, ll. 35-40).

(2) Offering of commodities on multiple parallel auction services was well known (See the rejection of claim 1).

(3) The various tasks to be performed by a third party service provider for a customer within the scope of the assignment, including communications tasks and other steps, was implicit and obvious to the performance of a third party service.

In this case, an ordinary practitioner of the art at the time of Applicant's invention would have found it obvious to combine the disclosures of Huberman and Official Notice with well known practices for the purpose of providing the service of an auction brokerage operation for a user customer, motivated by an opportunity to establish better prices for the sale of commodities through a more efficient auction process through electronically networked, highly automated, brokered auctions (Huberman, Col. 2, ll. 50-51, 55-56).

Re. Claims 6 & 9, Huberman does not explicitly disclose the detailed specifics of a method and means for execution comprising a step of requesting the auction sites to alter the desired price specified by the user according to the instruction of the auction user if no bid has been found by the specified date. However, it would have been obvious to an ordinary practitioner at the time of Applicant's invention to have notify the computing environment at the side of said auction organizers of alternation of the desired price according to the instruction of the auction user if no buyer has been found for said auctioned commodity at all of said auction organizers by the date specified by the auction user for the reasons stated in the rejection of claim 3. Therefore, an ordinary practitioner of the art at the time of Applicant's invention would have found it obvious to combine the disclosures of Huberman and Official Notice with well known practices for the purpose of requesting the auction sites to alter the desired price specified by the user according to the instruction of the auction user if no bid has been found by the specified date, motivated by an opportunity to establish better prices for

the sale of commodities through a more efficient auction process through electronically networked, highly automated, brokered auctions (Huberman, Col. 2, ll. 50-51, 55-56).

Re. Claims 7 & 10, Huberman does not explicitly disclose the detailed specifics of a method comprising a step of notifying the other auction sites of canceling the registration of the commodity but an auction site with which the trade has concluded. However, it would have been obvious to an ordinary practitioner at the time of Applicant's invention to have notify the computing environment at the side of said auction organizers of cancellation of registration when any buyer has been found at any of said auction organizers and the auction is terminated for the reasons stated in the rejection of claim 4, motivated by an opportunity to establish better prices for the sale of commodities through a more efficient auction process through electronically networked, highly automated, brokered auctions (Huberman, Col. 2, ll. 50-51, 55-56).

Response to Arguments

4. Applicant's arguments with respect to claims 1-10 filed December 4, 2006 have been fully considered but they are not persuasive, and are in part moot in view of the new ground(s) of rejection.

ARGUMENT: Neither Huberman nor Koopersmith discloses the brokerage computer used in the method of claims 1-7, and that the references do not disclose a computer that is equivalent to that claimed by Applicants in claims 8-10 (p. 10, l. 20 – p. 12, l. 2; summarized on p. 10, l. 20 – p. 11, l. 2, 19-20).

RESPONSE: By merely asserting certain differences between Applicant's claimed invention(s) and the Huberman nor Koopersmith prior art references, Applicant's arguments avoid the heart of the examiner's rejection rationale in this case of obviousness combination rejections as presented in the Office Action of July 3rd, 2006, with the rejection of claim 1 as exemplary (pp. 5-7). The rejection of claim 1 is based on Huberman in view of Koopersmith and well known practices supported by a large number of examples of industries which were practicing the gist of Applicant's claimed inventions at the time of Applicant's invention. These industries include eBay and the various stock markets and commodity markets which operate in the U.S. and around

the globe. These rejections are repeated above for Applicant's convenience. In other words, in the practices of these industries, the central market and the related brokerage firm "receives auction result information from the selected auction servers and notifies the user computer or information terminal of the auction result information" (Applicant's Remarks, p. 10, ll. 12-13).

Applicant is reminded of the bar established for rebutting an examiner's case of obviousness by reference to the following two court opinions:

(1) One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(2) "[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency' under 35 U.S.C. 102, on prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977))." (**MPEP** § 2112.01).

In this case, Applicant has not met the rebuttal standard against the examiner's detailed exposition of rejection rationale made under the provisions of 35 USC 103(a).

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Richard E. Chilcot, can be reached on (571) 272-6777.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks, Washington D.C. 20231

or Faxed to (571)*273-8300* [Official communications; including After Final communications labeled "Box AF"]

or Faxed to *(571) 273*-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

February 22, 2007

FRANTZY POINVIL
PRIMARY EXAMINER
Au 3692